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No. 91-971

Supreme Court, U.S.
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IN THE
Supreme Court of the United States

OCTOBER TERM, 1991

TWO PESOS, INC.,
Petitioner,
v.

TACO CABANA INTERNATIONAL, INC.,
and TACO CABANA, INC.,
Respondents.

**On Writ of Certiorari to the
United States Court of Appeals
for the Fifth Circuit**

**RESPONDENTS' REPLY TO PETITIONER'S RESPONSE
TO MOTION OF RESPONDENTS TO DISMISS THE WRIT
AS IMPROVIDENTLY GRANTED**

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Petitioner has offered no persuasive response to our motion to dismiss the writ as improvidently granted, which was filed to raise the newly available ground that petitioner has abandoned any argument on the only legal question as to which this case presented a circuit conflict—namely, whether, under the pre-1989 language of Section 43(a) of the Lanham Act (the version at issue in this case, which arose prior to 1988), secondary mean-

ing had to be shown for an inherently distinctive trade dress.¹

First, petitioner does not and cannot point to any portion of its brief that argues for the Second Circuit rule, in conflict with the rule in the Fifth, Seventh, and Eleventh Circuits, that secondary meaning had to be shown even for an inherently distinctive trade dress. Instead, petitioner says that it is entitled to withhold all argument on this entire issue from its opening brief and present any arguments on the issue, after seeing the briefs of respondents and *amici*, in a reply brief and oral argument. See Response, points 5-9 of the summary of argument & part IV. But that is patently improper appellate practice; it is nothing more than a form of sandbagging that is grossly unfair to respondents. Quite simply, given petitioner's brief, the case no longer presents the straightforward legal issue whether, under the pre-1989 Section 43(a), proof of secondary meaning (present consumer source association) was required even when there was proof that the trade dress was inherently distinctive (intrinsically distinguishing, not descriptive, generic, or functional).²

Second, petitioner's argument that there is a different certworthy issue in its brief is demonstrably wrong. The

¹ As an initial matter, as we previously explained (Motion 1-2 & n.1), the motion is procedurally proper. It cannot be barred by Rule 15.4, which merely directs all *pre*-grant responses to a petition to be included in the brief in opposition; otherwise, even post-grant motions to dismiss based on mootness or intervening statutory changes would be barred. And dismissal of the writ as improvidently granted is *not* exclusively a matter for *sua sponte* action by the Court: motions by respondents asking for such relief are appropriately filed and, where meritorious, have in fact been granted. See Motion at 1 (citing *Montgomery* and *New York State Parole Board*, where Court granted respondents' motions to dismiss writs as improvidently granted).

² While petitioner suggests that it may rely on *amici* to raise the issue (Response, point 7 of summary of argument), this Court has pointed out: "we do not ordinarily address issues raised only by *amici*." *Kamen v. Kemper Financial Services, Inc.*, 111 S. Ct. 1711, 1717 n.4 (1991).

Second Circuit has never so confused the concepts of secondary meaning and inherent distinctiveness, as petitioner suggests without any citation (Response, point III), as to hold that "proof of secondary meaning is required in order for a trade dress to be inherently distinctive." The Second Circuit has simply held that the former had to be proved to establish liability under Section 43(a) (in its pre-1989 version). See *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 303-04 (2d Cir. 1981), *cert. denied*, 455 U.S. 909 (1982). Similarly, the Ninth Circuit in the *Fuddruckers* case did *not*, as petitioner asserts (Response, point III), "preclude[] the possibility of inherent distinctiveness if secondary meaning does not exist." Rather, explicitly refusing to decide the relationship between secondary meaning and inherent distinctiveness, the Ninth Circuit in *Fuddruckers* simply held that, on the facts in front of it, no inherent distinctiveness had been shown. 826 F.2d at 843-44. More generally, petitioner's contention that inherent distinctiveness is somehow legally impossible in the absence of secondary meaning is unsupported, as far as we are aware, by *any* circuit-court holding on the meaning and requirements of Section 43(a) (either under the version at issue in this case or under the present language of the provision).

In short, no legal issue warranting this Court's review is now in this case. It is therefore respectfully submitted that the petition for a writ of certiorari should be dismissed as improvidently granted.

Respectfully submitted,

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